

REMARKS

In the Final Action the Office has maintained the rejection of claims 1-2 under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ishii et al. (U.S. Patent No. 6,790,563) (hereinafter: "Ishii") and the rejection of claims 3-4 under 35 U.S.C. 103(a) as being obvious over Ishii in view of Tani et al. (U.S. Patent No. 6,649,304) (hereinafter: "Tani") that were made in the first action.

Applicants respectfully submit that the rejections are improper because they are based on an unreasonably broad and improper interpretation of the terminology "hydrogen absorbing alloy" and "alkaline electrolyte" in the rejected claims. The terminology "hydrogen absorbing alloy" and "alkaline electrolyte" are art-recognized terminology in the art of nickel metal hydride storage batteries and have fixed meanings that exclude the interpretations made by the Office.

Nickel metal hydride batteries are well-known in the art.<sup>1</sup> Such batteries are defined as being similar to a nickel-cadmium battery but having a hydrogen absorbing alloy for an anode instead

---

<sup>1</sup>For example, a search of the USPTO databases shows that the terminology "nickel metal hydride battery" appears in the claims of 86 U.S. patents and the terminology "nickel metal hydride storage battery" appears in the claims of 18 U.S. patents.

of cadmium. (See the attached definition of "Nickel metal hydride battery" from Wikipedia).

The hydrogen absorbing alloy of a nickel metal hydride battery is a specific type of alloy capable of reversibly absorbing and releasing hydrogen. (See the attached definition of "hydrogen-absorbing alloy" from Nickel Metal Hydride Handbook, pages 7-8, August 2005, and page 41, August 2000). See also U.S. Patent No. 7,005,212 ("an alloy capable of storing hydrogen") and U.S. Patent No. 6,759,165 ("Hydrogen-absorbing alloy is known as being capable of stably absorbing and storing hydrogen several ten thousands times (calculated as a gas under normal temperature and pressure) as much as of its own volume. Therefore, hydrogen-absorbing alloy is noticed as a promising material for safely and easily storing, keeping and transporting hydrogen as an energy source").

It is respectfully submitted, therefore, that the terminology "hydrogen absorbing alloy" used in the claims of the present application has a specific meaning as an alloy which is capable of reversibly absorbing and releasing hydrogen and does not read on an alloy such as that disclosed as a negative electrode in Ishii which is not capable of reversibly absorbing and releasing hydrogen and

in which an acid is merely present on the surface of the electrode<sup>2</sup>.

It is further noted that although the terminology "nickel metal hydride" appears in the preamble of the claims, it is a limitation that must be given weight.

The United States Court of Appeals for the Federal Circuit has stated that:

Whether to treat a preamble as a limitation is a determination "resolved only on review of the entire[ ] ... patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989); see also *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572-73, 40 USPQ2d 1481, 1488 (Fed. Cir. 1996) ("Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history.").

In general, a preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. *Pitney Bowes*, 182 F.3d at 1305. Conversely, a preamble is not limiting "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the

---

<sup>2</sup>Applicants also note that the additive on the surface of the negative electrode of Ishii is described as "adsorbing on the negative electrode" (Col. 8, lines 26-27) and for this reason also the electrode cannot be properly interpreted as being a hydrogen adsorbing alloy.

invention." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

*Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 62 USPQ2d 1781, 1784 (2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 51 USPQ2d 1161 (Fed. Cir. 1999)).

The court has also stated: "[I]f the preamble helps to determine the scope of the patent claim, then it is construed as part of the claimed invention." *NTP, Inc. v. Research In Motion, Ltd.*, 73 USPQ2d 1231 (2004). See also *Griffin v. Bertina*, 62 USP2d 1431, 1434 ("A preamble to a claim has the import that the claim as a whole suggests for it").

In the present case, the recitation "nickel metal hydride storage" is necessary to give life, meaning, and vitality to the claim and operates to limit the elements recited in the body of the claim to those useful for a nickel metal hydride storage battery.

Regarding the terminology "alkaline electrolyte", in the context of a nickel metal hydride storage battery, this terminology refers to NaOH, KOH and LiOH. See, for example, U.S. Patent No. 7,005,212 and the enclosed page from the nickel metal hydride handbook.

Applicants' position that the terminology "hydrogen absorbing alloy" and "alkaline electrolyte" are art-recognized terminology having specific, limited meanings which exclude the alloy and

electrolyte of Ishii were discussed with the Examiner in charge of the present application, Ms. Jane Rhee, on May 31, 2006. Ms. Rhee indicated that she would consider applicants' position and would likely consult with her supervisor and other examiners concerning the meaning to be given to the terminology "hydrogen absorbing alloy" and "alkaline electrolyte" in the claims of the present application.

For the above reasons, Ishii is insufficient to support anticipation of the claims of the present application under 35 U.S.C. § 102 and, alone or combined with Tani, is insufficient to support a case of *prima facie* obviousness of the claims of the present application under 35 U.S.C. § 103(a).

Removal of the 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a) rejections of the claims of the application and a notice of allowability of the claims are in order and are respectfully solicited.

The foregoing is believed to be a complete and proper response to the Office Action dated March 6, 2006, and is believed to place this application in condition for allowance.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of

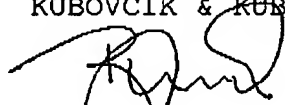
PATENT APPLN. NO. 10/625,724  
RESPONSE UNDER 37 C.F.R. §1.111

**PATENT  
NON-FINAL**

time. The fee for any such extension may be charged to Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,  
KUBOVCIK & KUBOVCIK



Ronald J. Kubovcik  
Reg. No. 25,401

Attachments: -Wikipedia, "Nickel metal hydride battery" (3 pages)  
Nickel Metal Hydride Handbook, pages 7-8, August 2005  
-Nickel Metal Hydride Handbook, page 41, August 2000  
-U.S. Patent No. 7,005,212 (Cols. 1 and 2)  
-U.S. Patent No. 6,759,165 (Cols. 1 and 2)

Atty. Case No. SNY-035  
The Farragut Building  
Suite 710  
900 17th Street, N.W.  
Washington, D.C. 20006  
Tel: (202) 887-9023  
Fax: (202) 887-9093  
RJK/KTK/jjk